

REMARKS / DISCUSSION OF ISSUES

Claims 1-20 are presently under consideration in the application. Claims 1 and 7 are independent claims.

Office Action does not comply with 37 C.F.R § 1.114

37 C.F.R § 1.114 states, with emphasis added:

(a) If prosecution in an application is closed, **an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:**

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
- (2) Abandonment of the application; or
- (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

Applicants provided a response to satisfy the requirement of a submission in conjunction with the filing of the RCE. All requirements of the noted Rule were satisfied.

In the response, Applicants addressed each and every issue raised by the Examiner and, substantively traversed the propriety of the rejection. The entry and consideration of this response was requested in the filing of the RCE. All fees were paid. In exchange therefore, Applicants are entitled to full and complete consideration of the response and especially evidence of patentability.

The present Office Action provides no indication of further consideration as required under Rule 114 and MPEP § 706. To wit, the present Office Action is verbatim the previous non-final rejection; and does not address the arguments for patentability provided in the response under Rule 111. This renders the present rejection as improper under Rule 114.¹ Notably, Applicants have no basis from which to further their cause for patentability. To this end, Applicants cannot determine any more the Examiner's

¹ Applicants note that the Advisory Action deems the arguments of the response under Rule 111 as not persuasive. No further explanation is provided, rendering this unsubstantiated and conclusory. This cannot be a suitable substitute for continued examination.

position than they could in the previous response; and are unable to analyze the Examiner's further position in view of the response under Rule 111 and to make a suitable response therefrom.

Accordingly, and for at least the reasons set forth above, Applicants submit that the present rejection is improper and that full consideration of the response under Rule 111 be given in a subsequent communication from the Office. As such, withdrawal of the present rejection is earnestly solicited and suitable consideration under Rule 114 is respectfully requested.

Rejections under 35 U.S.C. § 102²

1. Claims 1, 2 and 7 are rejected under 35 U.S.C. §102(b) as being anticipated by *Zavislan, et al.* (U.S. Patent 5,653, 706.)
2. Claims 1-20 are rejected under 35 U.S.C. §102(e) as being anticipated by *Cense, et al.* (U.S. Patent 6,976,984.)

i. Response to Rejections based on Applied Art

a. The Office Action fails to articulate a prima facie case of anticipation

Applicants submit that the final Office Action (the 'Office Action') fails to properly articulate a rejection and thus fails to provide a *prima facie* case of anticipation. At the outset, Applicants submit that the Office Action fails to comply with MPEP § 706. To wit, this section of the MPEP states, inter alia:

"The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity."

² The present traversal of the rejection of claims is a duplication of the traversal provided in the response under Rule 111 previously. This traversal is provided to ensure responsiveness to substantive rejections on the part of Applicants. The duplication is believed to be proper because the present rejection appears to be identical to the rejection set forth in the non-final Office Action.

Moreover, "...the examiner has the burden of persuasion and therefore the initial burden of production. Satisfying the burden of production, and thus initially the burden of persuasion, constitutes the so-called prima facie showing. Once that burden is met, the applicant has the burden of production to demonstrate that the examiner's preliminary determination is not correct." (*In re Oetiker* 24 USPQ 2d 1443, 1447) In addition, "...the examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner. The 'prima facie case' notion, the exact origin of which appears obscure (see *In re Piasecki*, 233 USPQ 785, 788 (Fed.Cir. 1984)), seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument. To that extent the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness." (*In re Oetiker* 24 USPQ 2d 1443, 1447).

The Office Action relies on Figs. 1-4 and 9 of *Zavislan, et al.* and Fig. 1 of *Cense, et al.* in the rejections of claims 1 and 7 and claims 1-20, respectively. However, the Office Action fails to specifically cite in reference character or text of either *Zavislan, et al.* or *Cense, et al.* where any feature, thus the cited feature of claim 1 is disclosed.

Respectfully, Applicants submit that rather than provide sufficient evidence supporting the rejection of the claims based on *Zavislan, et al.*, the Office Action requires Applicants to review the reference and determine the differences between the claims under examination and the teachings of the reference. Thus, Applicants are saddled with the initial burden of establishing patentability over the reference without the proper establishment of a prima facie case of anticipation by the Office as required. This is wholly improper and renders the rejection improper.

b. *Zavislan, et al.* fails to disclose a laser beam that provides laser induced optical breakdown phenomenon

Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Claim 1 is drawn to a device for shortening hair and features:

“...[a] laser beam provides laser induced optical breakdown phenomenon as to the hair tissue so as to damage the hair tissue via a mechanical effect.”

Claim 7 includes a similar feature.

As previously noted, the reference to *Zavislan, et al.* does not disclose the laser induced optical breakdown of the hair tissue. Rather, at col. 4, lines 64-66, the reference discloses that the “hair follicle and its adjacent blood vessels are destroyed by the heat produced by the absorbed laser energy (i.e., photothermolysis occurs).”

There is no disclosure or description of the laser induced **optical** breakdown phenomenon as claimed, but rather heating through photothermolysis. Accordingly, the reference fails to disclose at least one element of claims 1 and 7 and thus cannot serve to establish a *prima facie* of anticipation. Therefore, claims 1 and 7 and the claims that depend therefrom are patentable over the reference to *Zavislan, et al.*

c. Cense, et al. also fails to disclose a laser beam that provides laser induced optical breakdown phenomenon

The reference to *Cense, et al.* discloses "...the laser beam 9 is activated, during a predetermined period of time and with a predetermined intensity,...so that the hair roots 39 present **are heated** and die." (Emphasis provided. See column 5, lines 43-47 of the reference.)

The reference thus discloses heating the hair roots 39 with the laser beam 9, but does not disclose or describe the laser induced optical breakdown phenomenon as specifically recited in claims 1 and 7. Therefore, the reference fails to disclose at least one element of claims 1 and 7 and thus cannot serve to establish a *prima facie* of anticipation. Therefore, claims 1 and 7 and the claims that depend therefrom are patentable over the reference to *Cense, et al.*

ii. Rebuttal of Examiner's Response to Arguments

The Examiner asserts that: "...the recited claim language (the laser beam provides LIOB so as to mechanically damage hair) is directed to expected result/intended use. This recitation adds no functional and/or structural limitation to the claims and therefore is not given patentable weight."

The Examiner provides no basis in law in support of the contention of what is regarded as an expected result or an intended use. Furthermore, as phrased, it would appear that these terms are fungible. This is not correct as an expected result and an intended use are disparate in meaning and thus not interchangeable. At least because no basis is provided for the assertions, Applicants submit that these assertions cannot properly refute Applicants arguments in support of patentability.

The above notwithstanding, Applicants submit that the language in question is not properly classified as intended. Normally, intended use language is called into question with respect to preamble language of a claim. As is known: "An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates. But as we explained in

Griffin v. Bertina, 285 F.3d 1029, 62 USPQ2d 1431 (Fed. Cir. 2002), preamble language will limit the claim if it recites not merely a context in which the invention may be used, but the essence of the invention without which performance of the recited steps is nothing but an academic exercise. *Boehringer Ingelheim Vetmedica Inc. v. Schering-Plough Corp.*, 65 USPQ2d 1961 (Fed. Cir. 2003).

The noted opinion implies that 'intended use' is directed to the context of operation of an invention. However, the language of the claims in question, a *laser beam provides laser induced optical breakdown phenomenon as to the hair tissue*, does not relate to the context of an invention, but rather to an elements of a claim provided in a certain arrangement that brings about a particular result. Therefore, the assertion that the claim language is merely an intended use is unfounded.

The Examiner also alleges that the result of the devices of claims 1 and 7 are expected. However, the Examiner provides absolutely no evidence as to why the result is expected. If the Examiner has found that the elements of claims 1 and 7 were expected at the time of Applicants' invention, such evidence is respectfully requested. If this knowledge is based on the personal purview of technical information of the Examiner, an affidavit under 37 C.F.R. 1.104 (d)(2) is respectfully requested. If neither of the requested extrinsic evidence is provided, Applicants respectfully request withdrawal of the assertions under present discussion.

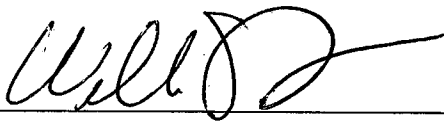
Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

A handwritten signature in black ink, appearing to read 'William S. Francos', is written over a horizontal line.

by: William S. Francos (Reg. No. 38,456)

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